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Amdt. Dated 8/30/2004
Response to Office action dated 06/30/2004

REMARKS

Claims 1-29 are pending. No new matter has been added.

Disclaimers Relating to Claim Interpretation and Prosecution History Estoppel

Claims 1, 10, 17, and 22 have been amended notwithstanding the belief that these claims were allowable. Except as specifically admitted below, no claim elements have been narrowed. Rather, cosmetic amendments have been made to the claims and to broaden them in view of the cited art. Claims 1, 10, 17, and 22 have been amended solely for the purpose of expediting the patent application process, and the amendments were not necessary for patentability.

Any reference herein to "the invention" is intended to refer to the specific claim or claims being addressed herein. The claims of this Application are intended to stand on their own and are not to be read in light of the prosecution history of any related or unrelated patent or patent application. Furthermore, no arguments in any prosecution history relate to any claim in this Application, except for arguments specifically directed to the claim.

Interview Summary

A telephone interview was conducted on August 26, 2004 at 11am EST. Claim 1 was discussed in relation to prior art reference Radziewicz, et. al (USP 5,854,897). The Practitioner asserts that Radziewicz's "idle" is different than the claimed "inactivity." With regard to the feature, "the client application monitoring the user's interaction with the local device with respect to the client application and thereby detecting whether the user is interacting with the online service," the Examiner agreed that an amendment adding the phrase, "wherein interaction is manipulating the input device" would distinguish claim 1 from the cited portions of Radziewicz. However, no agreement was reached as to patentability.

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Claim Rejections - 35 USC § 102

The Examiner rejected claims 1-5, 8, 10-14, 17-26, and 29 under 35 USC § 102(a, e) as anticipated by Radziewicz, et al. (USP 5,854,897). This rejection is respectfully traversed.

Radziewicz is directed to transmitting and displaying advertisements to data terminal equipment (DTE) while the connection path of the DTE to a network is idle (See Radziewicz, 5:43-47). In Radziewicz, the user of the DTE must first voluntarily subscribe to the optional advertisements (See Radziewicz, 6: 39-45). Only after the user has elected to receive advertisements will advertisements be both transmitted to the DTE and displayed on a DTE display window while the connection path is idle (See Radziewicz, 7:3-17).

To anticipate a claim, the reference must teach each and every element of the claim. MPEP § 2131 provides:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. [. . .]
The identical invention must be shown in as complete detail as is contained in the ... claim.

Claim 1:

Claim 1 is independent. Claim 1 recites, among other features, "[a] method of displaying advertisements to a user of an online service using a client application on a local device." The Examiner asserts

[t]here are other aspects or operations carried out by the client application which are not necessarily restricted to the confines of the local device. As pointed out in the Application Specification on page 25 lines 7-10, "Although at least some aspects of the client application 110 should be operable from the local device 100, the client application 110 need not be stored on the local device 100 and can be run from a remote location." Accordingly, all operations of a client application need not be at the local device.

However, "client application", as recited in claim 1, is limited to "client application on a local device." It is improper to broaden "client application on a local device" to "client application,

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wherein the client application need not be at the local device.” Since Radziewicz does not teach each and every element of claim 1, Radziewicz does not anticipate claim 1. Therefore the rejection should be withdrawn.

In addition, claim 1 recites, among other features,

if the user has not interacted with the local device with respect to the client application for a predetermined amount of time, the client application causing a dialog to be displayed on the output device of the local device, wherein the dialog notifies the user that the user has been inactive with respect to the online service, and wherein a display associated with a resource locator is displayed in the dialog.

The Examiner contends that Radziewicz shows

if the user has not interacted with the local device (14) with respect to the client application (20, 24) for a predetermined time, the client application (26) causing a dialog (Fig. 8A-8D, 66, 76, 82, 84) to be displayed on the output device of the local device (14), wherein the dialog notifies the user that the user has been idle with respect to the online server (12, 20) by displaying resource locator in the dialog (5:46-6:6, 12:23-45).

The claim language does not recite “idle” as defined in Radziewicz. The claim language recites “inactive.”

User inactivity, as recited in the claim, refers to “the user failing to interact with the local device 100 for a predetermined time span” (See Specification, p. 34, lines 3-4). The focus is on the user. Interaction refers to “manipulating a computer input device, such as a keyboard or mouse, with respect to a local device, and preferably with respect to the client application 200 or the browser window 300” (See Specification p. 34, lines 6-8). “The client application preferably monitors the user interaction such as monitoring whether the user moves a mouse” (See Specification p. 34, lines 8-9). If the user doesn’t interact with computer relative to the client window, a dialog is displayed notifying the user that there has been no interaction for a predetermined time.

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Radziewicz describes "idle" as the time when "a device connected to a computer or other network device by a transmission or communications medium is not presently sending or receiving any information over the transmission medium" (See Radziewicz, 3:57-63).

Although the advertisements are transmitted to the DTE 14 when the connection path 20 is idle, the last advertisement to be displayed prior to the connection path 20 becoming busy will continue to be displayed while the connection path 20 is busy. The advertisement will thus remain displayed until such time as the connection path 20 is no longer busy and another advertisement is transmitted to the DTE 14 or until the user aborts or terminates the session
(See Radziewicz, 13:34-44).

As set forth above, Radziewicz's "idle" involves perceiving a lack of network traffic and is fundamentally different from "the dialog notifies the user that the user has been inactive with respect to the online server" as claimed. Radziewicz's focus is the communication line between the DTE and the server. If the communication line is idle, advertisements are transmitted. If the communication line is busy, the transmitted advertisements are displayed. There is no monitoring a user's interaction with the local computer for any reason. Moreover, there is no dialog display notifying the user that there has been no interaction for a predetermined time period. Since Radziewicz does not teach each and every element of claim 1, Radziewicz does not anticipate claim 1. Therefore the rejection should be withdrawn.

In current amended form, it is believed that claim 1 is in proper form for allowance. It is respectfully requested that claim 1 be allowed to issue. Further, all claims depending on claim 1 are patentable over Radziewicz for the same reasons.

To the extent that claims 10, 17, and 22 have features similar to claim 1, the arguments set forth for claim 1 are applicable to claims 10, 17, and 22. Therefore, claims 10, 17, and 22 are patentable over Radziewicz for the same reasons as set forth in claim 1. Further, all claims depending on claims 10, 17, and 22 are patentable over Radziewicz for the same reasons as set forth in claim 1.

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In addition, claim 10 recites, among other features, "the client application removing the window from the output device of the local device if the user has not interacted with the window for a predetermined amount of time." The Examiner asserts that

Radziewicz shows that the client application removing the window from the output device of the local device that has not interacted with the window for a predetermined amount of time via a timeout process which logs the user out and removes a client application windows from the users display screen (col. 15 lines 30-35, fig. D).

In response the user aborting the session, Radziewicz, at 15:30-35, "logs or records all relevant information about the advertising messages that were transmitted to the DTE 14, and stores such information in a database in its storage device 32, and then finishes processing at step 116." The cited portion of Radziewicz is not focused on "interaction." Since Radziewicz does not teach each and every element of claim 10, Radziewicz does not anticipate claim 10. Therefore the rejection should be withdrawn.

Claims 2- 5, 8, 11-14, 18-21, 23-26, and 29:

Dependent claims 2- 5, 8, 11-14, 18-21, 23-26, and 29 are patentable over Radziewicz by virtue of their dependency on claims 1, 10, 17 or 22. In addition, some of the dependent claims recite other patentable features as set forth below.

Claim 4 and 25:

Claim 4 and 25 recite, among other features, "the client application pausing the play list if the user has not interacted with the local device with respect to the client application for the predetermined amount of time." The Examiner asserts that "Radziewicz shows the play list of announcements being "paused" via the logout procedure which logs or records all the relevant information about the advertising messages that were transmitted to the DTE so that when the user logs back in, ads will begin where they left off (col. 15, lines 29-35). Radziewicz, at 15:29-35, "logs or records all relevant information about the advertising messages that were transmitted to the DTE

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14, and stores such information in a database in its storage device 32, and then finishes processing at step 116." The cited portion of Radziewicz is not relevant to "the play list." The cited portions of Radziewicz is focused on the advertising messages that were transmitted to the DTE. Since Radziewicz does not teach each and every element of claims 4 and 25, Radziewicz does not anticipate claims 4 and 25. Therefore the rejection should be withdrawn.

Claim 13:

To the extent that claim 13 has features similar to claim 3, the arguments set forth for claim 3 are applicable to claim 13. Therefore, claim 13 is patentable over Radziewicz for the same reasons as set forth in claim 3.

Claim 20:

Claim 20 recites, among other features, "the client application closing the communication channel if the user has not interacted with the local device with respect to the client application for a predetermined amount of time." The Examiner asserts that "Radziewicz shows logout procedure or abort procedure which effectively closes communication path with the online service (col. 16 lines 20-22)." The logout procedure of Radziewicz, at 16:20-22, is not related to whether "the user has not interacted with the local device." Since Radziewicz does not teach each and every element of claim 20, Radziewicz does not anticipate claim 20. Therefore the rejection should be withdrawn.

Claim Rejections - 35 USC § 103

The Examiner rejected claims 6, 7, 27, and 28 under 35 USC § 103(a) as obvious from Radziewicz, et al. (USP 5,854,897) in view of Tazoe, et al. (USP 6,326,985). This rejection is respectfully traversed.

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Tazoe is directed to a method of controlling the display screen of a computer (See Tazoe, 2:40-43). When the mouse cursor is located within a window for a predetermined time, the window is considered "active" and the standard content of that window is displayed (See Tazoe, 15:12-24). When the mouse cursor is located outside of a window for a predetermined time, the window is considered "inactive" and the standard content of that window is not displayed (See Tazoe, 15:45-54). In the inactive window, either in the background or the periphery of the active window, an alternate message may be displayed (See Tazoe, 15:54-61, 1:66-2:6).

"To establish a *prima facie* case of obviousness, [...] the prior art reference (or references when combined) must teach or suggest all the claim limitations." *MPEP 706.02(j)*. Even if, in *arguendo*, the features of Radziewicz and Tazoe were combinable, they would still fail to teach each and every feature of the claimed invention.

Claims 6, 7, 27, and 28:

Claims 6-7 and 27-28 are respectively dependent from claims 1 and 22. As set forth above in the argument regarding the § 102 rejection of for claims 1 and 22, Radziewicz fails to teach each and every element of claims 1 and 22. Since claims 6-7, and 27-28 are dependent from claims 1 and 22, Radziewicz fails to teach each and every limitation of claims 6-7, and 27-28. Therefore, claims 6-7, and 27-28 are not obvious in view of Radziewicz in further view of Tazoe. Thus, the rejection should be withdrawn and claims 6-7, and 27-28 should be allowed to issue.

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Claim Rejections - 35 USC § 103

The Examiner rejected claims 9, 15, and 16 under 35 USC § 103(a) as obvious from Radziewicz, et al. (USP 5,854,897) in view of knowledge known to one of ordinary skill in the art. This rejection is respectfully traversed.

"To establish a *prima facie* case of obviousness, [...] the prior art reference (or references when combined) must teach or suggest all the claim limitations." *MPEP 706.02(j)*. Even if, in arguendo, the features of Radziewicz and knowledge known to one of ordinary skill in the art were combinable, they would still fail to teach each and every feature of the claimed invention.

Claim 9:

Claim 9 is dependent from claim 1. As set forth above in the argument regarding the § 102 rejection of for claim 1, Radziewicz fails to teach each and every element of claim 1. Since claim 9 is dependent on claim 1, Radziewicz fails to teach each and every limitation of claim 9. Therefore, claim 9 is not obvious in view of Radziewicz in further view of "knowledge known to one of ordinary skill in the art." Thus, the rejection should be withdrawn and claim 9 should be allowed to issue.

Claims 15-16:

Claims 15 and 16 are dependent from claim 10. As set forth above in the argument regarding the § 102 rejection of claim 10, Radziewicz fails to teach each and every element of claim 10. Moreover, the Examiner has not set forth how "knowledge known to one of ordinary skill in the art" is both combinable with Radziewicz and teaches the features of claim 10 which Radziewicz fails to teach. The Examiner has failed to show how "knowledge known to one of ordinary skill in the art" cures the deficiencies of Radziewicz. Therefore, claims 15, and 16 are not obvious in view of Radziewicz in further view of "knowledge known to one of ordinary skill in the art." Thus, the rejection should be withdrawn and claims 15 and 16 should be allowed to issue.

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Claim 16:

The Examiner contended that Radziewicz shows "the displaying of a window (84) on top of another window on the output device after an idle time (Fig. 8D, 24:46-66)." Radziewicz's "idle" is described as the time when "a device connected to a computer or other network device by a transmission or communications medium is not presently sending or receiving any information over the transmission medium" (See Radziewicz, 3:57-63). Moreover, when Radziewicz is "idle", advertisements are downloading and displaying. However, claim 16 recites "the client application allows other windows to be displayed on top of the client window if the user has not interacted with the client window within the predetermined amount of time." Radziewicz's idle is fundamentally different than the claimed feature "if the user has not interacted with the client window within the predetermined amount of time." As such, Radziewicz fails to teach each and every element of claim 16. Therefore claim 16 is not obvious in view of Radziewicz in further view of "knowledge known to one of ordinary skill in the art," the rejection should be withdrawn and claim 16 should be allowed to issue.

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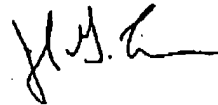
Conclusion

It is submitted, however, that the independent and dependent claims include other significant and substantial recitations which are not disclosed in the cited references. Thus, the claims are also patentable for additional reasons. However, for economy the additional grounds for patentability are not set forth here.

In view of all of the above, it is respectfully submitted that the present application is now in condition for allowance. Reconsideration and reexamination are respectfully requested and allowance at an early date is solicited.

The Examiner is invited to call the undersigned attorney to answer any questions or to discuss steps necessary for placing the application in condition for allowance.

Respectfully submitted,



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